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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Ivy Legal Placement, LLC

Serial No. 75/668,451

Ivy Legal Placement, LLC, pro se.

M. Catherine Faint, Trademark Examining Attorney, Law
Office 103 (Michael Hamilton, Managing Attorney).

Before Cissel, Seeherman and Drost, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Ivy Legal Placement, LLC has appealed from the final
refusal of the Trademark Examining Attorney to register IVY
LEGAL PLACEMENT as a mark for "professional legal
recruitment services."¹ Registration has been refused
pursuant to Section 2(d) of the Trademark Act, 15 U.S.C.

¹ Application Serial No. 75/668,451, filed March 25, 1999, and
asserting a bona fide intention to use the mark in commerce.

1052(d), on the ground that applicant's mark so resembles the mark IVY ASSOCIATES (with the word ASSOCIATES disclaimed), registered for "attorney placement consulting services"² that, if used on applicant's identified services, it would be likely to cause confusion or mistake or to deceive. The Examining Attorney has also made final, pursuant to Section 6(a) of the Act, 15 U.S.C. 1056(a), a requirement for a disclaimer of LEGAL PLACEMENT.

Applicant and the Examining Attorney have filed appeal briefs;³ an oral hearing was not requested.

We turn first to the requirement for a disclaimer. In applicant's request for reconsideration, it offered a disclaimer of LEGAL PLACEMENT "in the event the Examining Attorney reverses her determination [of the Section 2(d) refusal] and approves the proposed mark for registration." As the Examining Attorney noted in her appeal brief, this conditional offer does not constitute a disclaimer of the

² Registration No. 1,690,442, issued June 2, 1992; Section 8 and 15 affidavits filed; renewed.

³ Applicant's brief does not comply with Trademark Rule 2.142(b)(1), which requires, inter alia, that briefs be double spaced and in at least pica or eleven-point type. Because it appears that applicant's brief would have been within the twenty-five limit set forth in the rule if the brief had been submitted in the appropriate format, the Board has exercised its discretion and considered the brief. However, applicant is advised that, in future, strict compliance with the rules is expected.

term. Accordingly, we have considered the acceptability of the Examining Attorney's requirement.

Section 6(a) of the Trademark Act provides that the Director may require an applicant to disclaim an unregistrable component of a mark otherwise registrable. Section 2(e)(1) of the Act prohibits the registration of matter that is merely descriptive of the applicant's goods or services.

There is no dispute that the term LEGAL PLACEMENT is descriptive of legal recruitment services. Applicant concedes that LEGAL PLACEMENT means placements in the field of law. Brief, p. 4. However, applicant argues that no disclaimer is required because LEGAL PLACEMENT as used in the mark IVY LEGAL PLACEMENT forms a double entendre, playing on the sound of LEGAL following IVY as indicating "Ivy League" and suggesting that applicant's candidates are graduates of Ivy League or other top tier schools.

We are not persuaded by this argument. Although there is a similarity in sound between the first part of LEGAL and the word LEAGUE, we do not believe that consumers are likely to view IVY LEGAL PLACEMENT as a unitary term, such that the clear descriptive meaning of LEGAL PLACEMENT will

be subsumed in a reference to the IVY LEAGUE.⁴ Thus, this situation differs from that in, for example, **In re Colonial Stores Incorporated**, 394 F.2d 549, 157 USPQ 382 (CCPA 1968), in which the Court stated that, while the individual terms "sugar" and "spice" were descriptive of bakery products, when combined as the mark SUGAR & SPICE they lost their merely descriptive significance, and instead indicated the nursery rhyme and its reference to "everything nice." In the present case, the words LEGAL PLACEMENT retain their descriptive significance in the mark IVY LEGAL PLACEMENT, and therefore we affirm the requirement for a disclaimer.

This brings us to the issue of likelihood of confusion. Our determination of this issue is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in **In re E. I. du Pont de Nemours & Co.**, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key

⁴ In its brief applicant makes the comment that "Upon hearing the name of Applicant's firm, professionals at law firms, banks and Fortune 500 corporations routinely acknowledge the double entendre." p. 11. Aside from the anecdotal nature of this statement, it cannot be considered as evidence because, under Trademark Rule 2.142(d), the record must be complete as of the filing of the appeal. For similar reasons, applicant's statement in its brief that it was founded in 1998 cannot be considered as evidence that it began using the mark at that time. The application was filed in 1999 based on an asserted intention to use the mark, not on a claim of actual use in commerce.

considerations are the similarities between the marks and the similarities between the goods [or services].

Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

Applicant's services are identified as professional legal recruitment services. The cited registration is for attorney placement consulting services. The services, thus, are in part identical, as applicant's services include attorney placement/recruitment.

We now turn to a consideration of the marks, keeping in mind that when marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines. **Century 21 Real Estate Corp. v. Century Life of America**, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

Although marks must be compared in their entireties, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark. **In re National Data Corp.**, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). In this case, IVY is the dominant feature of both applicant's mark and the cited mark. The word ASSOCIATES in the cited mark, which has been disclaimed, is descriptive, and, as we discussed in connection with the disclaimer requirement, so is the term

LEGAL PLACEMENT in applicant's mark. Thus, it is the word IVY in each mark that consumers will look to as the source-identifying element. The differences in appearance and pronunciation resulting from the additional descriptive words in each mark are not sufficient to distinguish the marks.

As for the connotation of the marks, even if we accept applicant's argument that IVY will be perceived as a reference to the Ivy League, rather than as a purely arbitrary term, this connotation is the same for both marks. In this connection we take judicial notice of the dictionary definition of "ivy" submitted with the Examining Attorney's brief, i.e., "*Informal* A university in the Ivy League."⁵ Moreover, applicant has indicated that the word IVY "calls to mind an association with Ivy League colleges or graduates of those institutions," request for recon, p. 3, referring to such third-party registrations as IVY WEST for tutoring/test-prep service for students taking college entrance exams; IVY WISE for consulting services for choosing colleges; IVY LEARNING CENTER for tutoring

⁵ The American Heritage Dictionary of the English Language, 4th ed. 2000.

services; and SYLVAN IVY PREP for tutoring/test preparation, college selection services.⁶

Accordingly, we find that both applicant's mark and the cited mark convey the same commercial impressions.

Applicant has argued that IVY is a weak mark, asserting that "a search of the term 'ivy' on the U.S Trademark Electronic Search System (TESS) yields 266 records." Request for recon, p. 3.⁷ The only information about these third-party registrations and/or applications that applicant has provided is that "the various and sundry goods and services covered include treatments for poison ivy, linens, cough drops, dolls and doll clothing, real estate development and clothing." Request for recon, p. 3. Applicant has not provided evidence of third-party registrations for legal placement services or employment services of any kind. As a result, we cannot conclude that

⁶ Applicant did not follow the correct procedure for making third-party registrations of record, namely, by submitting copies of such registrations prepared by the U.S. Patent and Trademark Office or taken from the Office database. Thus, we do not have the registration numbers of these registrations, nor can we confirm that the services indicated by applicant are accurate. However, because the Examining Attorney did not object to the mere listings in applicant's papers at a point at which applicant could have corrected the error, and because the Examining Attorney has discussed some of the registrations in her brief, we have considered the limited information regarding the registrations which applicant has provided.

⁷ Again, applicant has not provided copies of the registrations, and has referred to them in the most general of terms.

IVY ASSOCIATES is a weak mark for attorney placement consulting services, and is entitled to a narrow scope of protection.

Applicant also asserts that in the legal placement field there are firms with similar names, and that in the metropolitan New York area such firms with registered trademarks include Special Counsel, Hire Counsel and Co-Counsel.⁸ Clearly, these examples are distinguishable from IVY ASSOCIATES and IVY LEGAL PLACEMENT. The term "counsel," which is common to those marks, is a highly descriptive term for legal placement services, such that consumers would expect to look to other elements of the marks to distinguish them. However, in the present case, the common term is the arbitrary or at most suggestive term IVY. The other marks mentioned by applicant are also distinguishable, e.g., the dominant words in Strategic Legal Resources and Stone Legal Resources are different, while the dominant word IVY in applicant's mark and the cited mark is the same.

Applicant also argues that the consumers of legal placement services are sophisticated and careful. In particular, applicant asserts that after a recruitment firm

⁸ Again, applicant has not submitted copies of such registrations.

is selected, it takes time for the recruiter to place a candidate, and that in the course of the placement process, clients interact and develop a close relationship with the recruiter. It appears that applicant is arguing that over the course of these dealings if there were any confusion, it would be corrected. However, we are concerned with the likelihood of confusion when a consumer contacts or engages the placement firm, not whether any misapprehension is ultimately corrected.

Applicant also asserts that in the legal placement business, clients typically pay placement fees ranging from 25% to 33% of the hired candidate's annual salary, and that it is common for recruitment firms to command a minimum of \$35,000 for placements of attorneys. Certainly a decision as to whether to hire a particular attorney will be made with great deliberation, but there is a distinction between hiring an attorney and hiring legal placement services. Because there is no indication that a customer must pay any fees to a legal placement company until a candidate is chosen, the decision to engage a company would not necessarily be undertaken with the same degree of care that would occur with the hiring of the individual attorney.

More importantly, applicant has stated that clients frequently select recruitment firms on the basis of

referrals, and we find that this would militate toward a finding of likelihood of confusion. That is, a partner in a law firm might say to a friend in another law firm that he was pleased with the services of the IVY firm, meaning registrant, and the second attorney might assume, upon seeing IVY LEGAL PLACEMENT, that this was the company that had been recommended. Even if the first attorney correctly referred to the registrant's services as IVY ASSOCIATES, the second attorney could make the same assumption upon seeing IVY LEGAL PLACEMENT. Quite simply, because the dominant term IVY is identical in both marks, even sophisticated customers are likely to assume that the marks IVY ASSOCIATES and IVY LEGAL PLACEMENT indicate services emanating from the same source.

Finally, applicant asserts that in the years that it has been in business, it has not received any complaints that clients or candidates have confused its services with those of the registrant. As we previously stated in footnote 4, there is no evidence in the record as to when applicant first began using its mark. Even if we assume that such use began in 1998, we cannot ascertain that there has been a significant opportunity for confusion to occur, such that we could assume from the lack of actual confusion that confusion is not likely to occur. We note that

applicant offers its services primarily in the New York area, as well as in Boston, Washington and Houston. On the other hand, applicant asserts, based on information it obtained from the registrant's website, that the registrant is located in California and describes itself as "Northern California's Premier Attorney Placement Specialists." If these statements are accurate, that would explain any lack of actual confusion. We would also point out that applicant has not provided any information as to the amount of its own business or the extent of its advertising, nor have we heard from the registrant as to any actual confusion which it may have encountered.

After reviewing the various duPont factors that are applicable, we find that if applicant were to use IVY LEGAL PLACEMENT for professional legal recruitment services it would be likely to cause confusion with IVY ASSOCIATES for attorney placement consulting services.

Decision: The refusal on the ground of likelihood of confusion and the requirement for a disclaimer of LEGAL PLACEMENT are affirmed.